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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,282	03/24/2000	Selda Gunsel	42053.6USPT	2884

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21
EXAMINER

BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 08/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/534,282

Applicant(s)

GUNSEL ET AL.

Examiner

Kevin M Bernatz

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,11-14 and 23-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,11-14 and 23-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Response to Amendment

1. Amendments to claim 25, filed on June 17, 2003, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Double Patenting

3. Applicant is advised that should claim 13^{/1} be found allowable, claim 14^{/13} will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). In the instant case, the structure in claim 14 is already present in claim 1.

Claim Rejections - 35 USC § 103

4. Claims 1, 11 – 14 and 23 – 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stirniman et al. ('600 B1) in view of Venier et al. ('023), Venier, Casserly and Gunsel (IDS reference titled "Tris (2-Octyldodecyl) Cyclopentane, a Low Volatility, Wide Liquid-range, Hydrocarbon Fluid") and Babb et al. ('547) for the reasons

Art Unit: 1773

of record as set forth in Paragraph No. 7 of the Office Action mailed on March 17, 2003 (Paper No. 19).

5. Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stirniman et al. ('600 B1) in view of Venier et al. ('023), Venier, Casserly and Gonsel and Babb et al. ('547) as applied above, and further in view of Patsidis et al. ('351) for the reasons of record as set forth in Paragraph No. 5 of the Office Action mailed on February 7, 2002 (Paper No. 12).

6. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stirniman et al. ('600 B1) in view of Venier et al. ('023), Venier, Casserly and Gonsel and Babb et al. ('547) as applied above, and further in view of Venier and Casserly (IDS reference from Symposium on the Chem. of Lubricants, Boston Meeting, pre-print, 35(2), 1990) for the reasons of record as set forth in Paragraph No. 6 of the Office Action mailed on February 7, 2002 (Paper No. 12).

7. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stirniman et al. ('600 B1) in view of Venier et al. ('023), Venier, Casserly and Gonsel and Babb et al. ('547) as applied above, and further in view of Sanechika et al. ('593) and Ng ('216) for the reasons of record as set forth in Paragraph No. 7 of the Office Action mailed on February 7, 2002 (Paper No. 12).

Art Unit: 1773

8. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stirniman et al. ('600 B1) in view of Venier et al. ('023), Venier, Casserly and Gonsel and Babb et al. ('547) as applied above, and further in view of Tsuchiya et al. ('516) and Hayushi ('983) for the reasons of record as set forth in Paragraph No. 8 of the Office Action mailed on February 7, 2002 (Paper No. 12).

Response to Arguments

9. The rejection of claims 33 and 35 under 35 U.S.C § 112 – 2nd Paragraph

The above noted rejection has been withdrawn in view of applicant(s) arguments, which have been found persuasive. Specifically, applicant(s) argue that the terms “higher” and “fine” are known to one of ordinary skill in the art and have provided references supporting their allegation. As such, the Examiner deems that one of ordinary skill in the art would have been readily appraised of the scope of the claim.

10. The rejection of claims 1, 11 – 14 and 23 - 35 under 35 U.S.C § 103(a) - Stirniman et al. ('600 B1) in view of Venier et al. ('023), Venier, Casserly and Gonsel and Babb et al. ('547), alone or in combination with various references

Applicant(s) argue(s) that the disclosure of a single embodiment comprising “greater than at least 29 carbon atoms” would not motivate one skilled in the art to combine the claimed references. The examiner respectfully disagrees.

The Examiner notes that a data point within a range is a *prima facie* case of anticipation of the range. The disclosed hydrocarbyl substituted cyclopentane

Art Unit: 1773

comprises 65 carbon atoms, which is clearly within applicants' claimed range of "at least 29 carbon atoms".

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (703) 308-1737. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Application/Control Number: 09/534,282

Page 6

Art Unit: 1773

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



KMB
August 2, 2003